

REMARKS

I. Status of the Claims

Claims 9, 10, 13, and 14 are currently pending in this application. Claims 15-20 have been canceled. Claims 6-8 have been withdrawn from consideration as non-elected claims. Claims 9 and 13 are currently amended. Support for this Amendment can be found, for example, at Figures 2 and 3 of the Specification. No new matter has been introduced by this Amendment.

II. Combination Rejections Under 35 U.S.C. §103(a)

Applicant appreciates and acknowledges withdrawal of the rejection of claim 10 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,714,065 to *Huder* in view of U.S. Patent No. 5,861,430 to *Markonius* in further view of U.S. Patent No. 5,011,602 to *Totani*. Claims 17 and 18 have been canceled, thus, rendering moot the new grounds of rejection introduced by the Examiner. Accordingly, the only rejection remaining, which has been maintained by the Examiner, is the rejection of claims 9, 10, 13, and 14 under 35 U.S.C. § 103(a) as allegedly unpatentable over *Huder* in view of *Markonius*. Applicant respectfully disagrees with and traverses this rejection for at least the reasons of record and the following reasons.

To establish a *prima facie* case of obviousness the Examiner must show that, *inter alia*, (1) there is a suggestion or motivation to combine the reference teachings, and that (2) all of the claimed elements are taught or suggested by the reference combination. M.P.E.P. § 2143. Neither of these requirements has been satisfied.

In the Office Action, the Examiner sets forth a test for obviousness, contending that the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. (Office Action dated October 28, 2003, page 4 (citing *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).) Applicant submits, however, that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000) (emphasis supplied). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (emphasis in original and emphasis supplied). In this case, no *prima facie* case of obviousness has been made at least because the Examiner has failed to provide an incentive for combining the references in the first place and because not all elements of the claims are taught or suggested by the reference combination.

In an attempt at hindsight reconstruction, which is improper, the Examiner pieces together independent portions of each reference. For example, the Examiner relies on *Markonius* to suggest that its propolis component is compatible with different types of carriers (col. 7. lines 45-67). (Office Action dated October 28, 2003, page 3.) The Examiner has failed, however, to establish that *Markonius* or even *Huder* provide any incentive to use a propolis component in an antibacterial filter for filtrating water, let alone a filter of claims 9, 10, 13, and 14. Clearly, this amounts to at most an after-the-fact reconstruction of the claims.

AMENDMENT AND REPLY AFTER FINAL REJECTION UNDER 37 C.F.R. § 1.116

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The Examiner's attempt at assembling the puzzle, by combining pieces of the cited references with Applicant's claims as a template, nonetheless, is insufficient in that not all elements of the claims are taught or suggested by the cited reference combination. Further, Applicant has amended claims 9 and 13, and the elements of the claims as amended too are neither taught nor suggested by the cited references.

As no *prima facie* case of obviousness has been presented by the Examiner, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103.

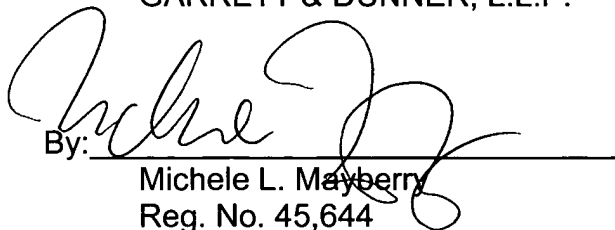
III. Conclusion

In view of the foregoing Amendment and Remarks, Applicant respectfully requests entry of the Amendment, reconsideration and reexamination of this application in light of the Amendment and Remarks, and the timely allowance of pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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